



ATTN: Mail Stop AF  
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED**

**SEP 25 2003**

**TECH CENTER 1600/2900**

In Re the Application of:

Sim, Gee-Kee  
Yang, Shumin  
Sellins, Karen S.

Serial No.: 09/646,561

Filing Date: March 19, 1999

Atty. File No.: IM-1-C1-PUS  
(formerly HKZ-029CPUS)

For: "CANINE AND FELINE B7-2  
NUCLEIC ACID MOLECULES AND  
USES THEREOF"

Group Art Unit: 1644

Examiner: Roark, Jessica H.

PETITION TO CORRECT  
INVENTORSHIP UNDER  
37 CFR 1.48(a)

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS  
BEING DEPOSITED WITH THE U.S. POSTAL SERVICE  
AS FIRST CLASS MAIL ADDRESSED TO MAIL  
STOP AF, COMMISSIONER FOR PATENTS, P.O.  
BOX 1450, ALEXANDRIA, VIRGINIA 22313-1450, THIS  
18 DAY OF SEPTEMBER 2003.

HESKA CORPORATION

By:

Susan A. Gordon

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

In accordance with 37 CFR 1.48(a), Applicants hereby petition the above-referenced patent application be amended to delete as an inventor Karen S. Sellins, having a residence of 1919 Enchantment Drive, Fort Collins, CO 80525.

The correct named inventors should be:

Gek-Kee Sim  
Shumin Yang

Applicants have included the following:

(1) a statement from the person being deleted that the error in inventorship occurred without any deceptive intent on her part;

(2) a Declaration by the actual inventor in accordance with 37 CFR 1.63. Applicants note that although inventor Gek-Kee Sim is listed on the Declaration, the Declaration has only been signed by inventor Shumin Yang. The USPTO previously granted a petition to accept the Application without the signature of co-inventor Gek-Kee Sim based on evidence showing co-inventor Gek-Kee Sim refused to execute the Application. Copies of supporting documentation to this effect have been included herewith; and

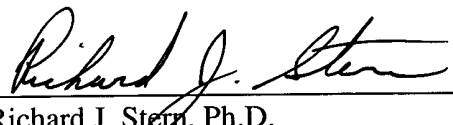
(3) written consent of the assignee as indicated by signature of the undersigned on behalf of Assignee, Heska Corporation.

Applicants authorize the petition fee of \$130, as required under 37 CFR § 1.17(i), to be charged to Deposit Account 081930.

The Examiner is invited to contact the undersigned should any issues remain.

Respectfully submitted,

Dated: September 18, 2003

By:   
Richard J. Stern, Ph.D.  
Registration No. 50,668  
Heska Corporation  
1613 Prospect Parkway  
Fort Collins, Colorado 80525  
Telephone: (970) 493-7272  
Facsimile: (970) 491-9976



ATTN: Mail Stop AF  
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED**

SEP 25 2003

Re the Application of:

Sim, Gee-Kee  
Yang, Shumin  
Sellins, Karen S.

) Group Art Unit: 1644

) Examiner: Roark, Jessica H.

) **STATEMENT OF LACK OF**  
) **DECEPTIVE INTENT**  
) Under 37 CFR 1.48(a)

Serial No.: 09/646,561

Filing Date: March 19, 1999

Atty. File No.: IM-1-C1-PUS  
(formerly HKZ-029CPUS)

For: "CANINE AND FELINE B7-2  
NUCLEIC ACID MOLECULES AND  
USES THEREOF"

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS  
BEING DEPOSITED WITH THE U.S. POSTAL SERVICE  
AS FIRST CLASS MAIL ADDRESSED TO MAIL STOP  
AF, COMMISSIONER FOR PATENTS, P.O. BOX 1450,  
ALEXANDRIA, VIRGINIA 22313-1450, THIS 18 DAY  
OF SEPTEMBER 2003.

HESKA CORPORATION

By:

*Susan A. Gordon*

Susan A. Gordon

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

The undersigned hereby states her erroneous inclusion as an inventor in the  
above-referenced Application occurred without deceptive intention.

Respectfully submitted,

Dated: September 15, 2003

By: Karen S. Sellins  
Karen S. Sellins, Ph.D.  
1919 Enchantment Drive  
Fort Collins, Colorado 80525



RULE 63 (37 CFR § 1.63)  
DECLARATION  
FOR PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

SEP 25 2003

TECH CENTER 1600/2900

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name, and I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled "CANINE AND FELINE B7-2 NUCLEIC ACID MOLECULES AND USES THEREOF", the specification of which was filed on March 19, 1999, receiving Serial No. 09/646,561, and identified as Attorney File No. IM-1-C1-PUS (formerly HKZ-039CPUS).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to patentability in accordance with 37 CFR §§ 1.56(a) and (b) as set forth on the attached sheet indicated Page 3 hereof and which I have read.


I hereby claim foreign priority benefits under 35 U.S.C. 119/365 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)			Priority Claimed
Number	Country	Day/Month/Year Filed	Yes No
PCT/US99/06187	PCT	19 March 1999	Yes

I hereby claim the benefit under 35 U.S.C. 120 of all United States and PCT international applications listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in such prior applications in the manner provided by the first paragraph of 35 U.S.C. 112, I acknowledge the duty to disclose information material to patentability in accordance with 37 CFR §§ 1.56(a) and (b) which occurred between the filing date(s) of the prior application(s) and the national or PCT international filing date of this application:

Application Serial No.	Filing Date
09/062,597	17 April 1998

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

1) Inventor's Signature  Date 9/12/03

Inventor's Name (typed): Shumin Yang, Ph.D.

Citizenship: United States of America

Residence: 765 San Antonio Road, #7~~8~~<sup>51</sup>  
Palo Alto, California 94303

Post Office Address: Same as Residence

2) Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_

Inventor's Name (typed): Gek-Kee Sim, Ph.D.

Citizenship: United States of America

Residence: 543 Franklin St.  
Denver, Colorado 80218

Post Office Address: Same as Residence

37 CFR §§ 1.56(a) and (b)  
DUTY TO DISCLOSE INFORMATION MATERIAL  
TO PATENTABILITY

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

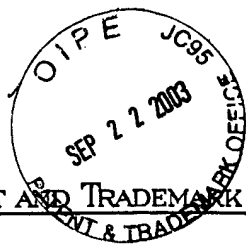
(ii) Asserting an argument of a patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.\*

\*Note, 37 CFR §1.97(h) states: "The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in §1.56(b)."



NOV 29 2001



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Elizabeth A. Hanley  
LaHive & Cockfield, LLP  
28 State Street  
Boston, MA 02109

COPY

ENTERED

RECEIVED

SEP 25 2003

DEC - 5 2001 TECH CENTER 1500/2900

RETRIEVED 12/5/00  
FORWARDED

In re Application of  
Gek-Kee Sim et al.  
Application No.: 09/646,561  
PCT No.: PCT/US99/06187  
Int. Filing Date: 19 March 1999  
Priority Date: 19 March 1998  
Attorney's Docket No.: HKZ-029CPUS  
For: T CELL COSTIMULATORY PROTEINS,  
SEQUENCES AND USES THEREOF

DECISION ON  
RENEWED PETITION  
UNDER 37 CFR 1.47(a)

This is a decision in response to the declaration and renewed petition filed under 37 CFR 1.47(a) on 17 September 2001, to accept the application without the signature of co-inventor Gee-Kee Sim. The required \$130 petition fee has been received.

### BACKGROUND

On 19 March 1999, applicants filed international application PCT/US99/06187, which claimed priority of an earlier US application filed 17 April 1998 and an earlier provisional application filed 19 March 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from applicant on 19 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 October 1999. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 19 September 2000.

On 19 September 2000, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c).

On 01 November 2000, the United States Designated/Elected Office mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/EO/EO905), indicating that an oath or declaration and the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) needed to be filed. The notification set a one month time period in which to respond.

(E)

On 01 February 2001, applicant filed a response to the PCT/DO/EO/905 including a petition under 37 CFR 1.47 (a) and the required petition fee, and the required surcharge for filing the declaration later than 30 months from the earliest priority date.

A decision of the petition was mailed to applicant on 17 May 2001 indicating that before a refusal to sign a declaration can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application.

On 17 September 2001, applicant filed the current Renewed Petition under 37 CFR 1.47(a) and a \$130 fee; the declaration of Timothy McCutcheon including various exhibits; the unexecuted declaration, petition and power of attorney; a request for a two-month extension of time and the required fee; and, a petition to revive and the appropriate fee.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

With respect to item (1), the \$130 petition fee under 37 CFR 1.17(h) was included with the original petition. Therefore, no additional fee is due. The enclosed \$130 fee will be refunded to applicant's deposit account.

With respect to item (2), Mr. Timothy McCutcheon states that he left various email and voice messages on Dr. Sim's telephone. Dr. Sim did not respond to any of the messages. Further, on 26 July 2001, Mr. McCutcheon sent Dr. Sim, by Federal Express, a spiral bound copy of the application as well as the assignment and declaration. On 27 July 2001, G. Sim signed for this package as evidenced by the "Track Response."

With respect to item (3), Dr. Sim's last known address is furnished in Mr. McCutcheon's declaration.

Regarding item (4), applicants included a Declaration signed by two of the three co-inventors with the original petition. The nonsigning co-inventor's name, residence, post office address and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) has been satisfied.

With respect to applicant's petition to revive, no such petition is necessary. Therefore, the fee of \$620 will be refunded to applicant's deposit account.



NOV 29 2001

COPY



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov



RECEIVED

SEP 25 2003

TECH CENTER 1600/2900

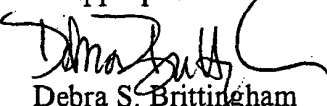
Elizabeth A. Hanley  
LaHive & Cockfield, LLP  
28 State Street  
Boston, MA 02109

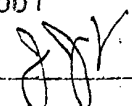
In re Application of  
Gee-Kee Sim et al.  
Application No.: 09/646,561  
PCT No.: PCT/US99/06187  
Int. Filing Date: 19 March 1999  
Priority Date: 19 March 1998  
Attorney's Docket No.: HKZ-029CPUS  
For: T CELL COSTIMULATORY PROTEINS,  
SEQUENCES AND USES THEREOF

Dear Dr. Sim:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

  
Debra S. Brittingham  
PCT Legal Examiner  
PCT Legal Office  
Telephone: (703) 308-3401  
Facsimile: (703) 308-6459

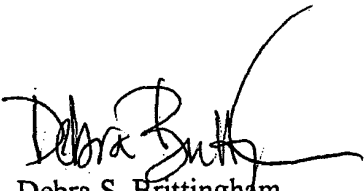
RECEIVED	
LAHIVE & COCKFIELD	
DOCKET DEPT.	
DEC - 3 2001	
RETRIEVED: 12/3	
FORWARDED:	

CONCLUSION


The petition under 37 CFR 1.47(a) is GRANTED.

Applicant's **DEPOSIT ACCOUNT 12-0080** will be refunded \$750.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision; and, if appropriate, a Notification of Acceptance of Application (Form PCT/DO/EO/903) will be mailed showing a 35 U.S.C. 371 date of 01 February 2001.



Debra S. Brittingham  
PCT Special Programs Examiner  
PCT Legal Office



Leonard Smith  
PCT Legal Examiner  
PCT Legal Office

DSB/LS:dsb

Telephone: (703) 308-3401

Facsimile: (703) 308-6459